

REMARKS**Status of the Claims**

This amendment is filed in response to the Office Action dated October 28, 2004. Claims 1-15 are pending. In the Office Action of October 28, 2004, the Examiner objected to FIGs. 1-5 because items 102 and 104 were labeled with the acronym "MAG" instead of the phrase "Media Access Gateway." The Examiner also objected to FIG. 1 because it was not labeled "Prior Art." The Examiner further objected to claims 1, 9, and 14 because the acronym "ATM" was used instead of the phase "Asynchronous Transfer Mode." In addition, the Examiner objected to claim 6 because it included the phrase "one of." The Examiner rejected claims 1-7 and 9-15 under 35 U.S.C. § 103(a) as being unpatentable over admitted prior art, FIG. 1, in view of Rogers et al., U.S. Patent No. 5,617,471 ("Rogers"). Finally, the Examiner objected to claim 8 as being dependent upon a rejected base claim, but otherwise allowable.

Objections to the Drawings

Submitted herewith is a corrected FIG. 1 with a legend indicating that FIG. 1 is "Prior Art." This obviates the Examiner's objection in this regard.

With respect to the Examiner's objection to items 102 and 104 in FIGs. 1-5, the Applicants respectfully disagree that MAG is not a descriptive text label. MAG is a descriptive text label, and it is clearly defined in the specification at page 1, line 30 and, again, at page 6, line 17. Furthermore, 37 C.F.R. § 1.84 does not provide any prohibitions on the use of acronyms in the figures. The Applicants believe that re-labeling "MAG" as Media Access Gateway will needlessly clutter the figures and de-emphasize the system described therein. Thus, the Applicants respectfully request that the Examiner withdraw the objection to FIGs. 1-5.

Amendment of the Claims

By this amendment, claims 1-15 are amended in accordance with the Examiner's suggestions to overcome the objections to those claims. More specifically, the acronym "ATM" is replaced in claims 1-5 and 7-14, and the phrase "one of" has been deleted from claim 6. Furthermore, claim 8 is rewritten in independent form to include all of the limitations of its base claim and any intervening claims. As amended, these claims overcome the Examiner's objections. In particular, claim 8, which was merely objected to, is rewritten to conform to the allowable status the Examiner previously indicated.

Claims 1-7 and 9-15 are Allowable over Figure 1 in view of Rogers

The Examiner rejected claims 1-7 and 9-15 under 35 U.S.C. § 103(a) as being unpatentable over admitted prior art, FIG. 1, in view of Rogers et al., U.S. Patent No. 5,617,471 ("Rogers"). The rejection is traversed on the basis that a *prima facie* case of obviousness is not established for two independent reasons. First, Rogers is not analogous art. Second, there is no suggestion or motivation to combine these references.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP § 2141.01(a) quoting *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). Even though the present invention and Rogers both disclose networks for providing similar services, e.g. transferring a call, the disclosure of Rogers is not applicable to the present invention. The present invention discloses a method and apparatus for transferring services in a network using Asynchronous Transfer Mode ("ATM") switches. ATM networks are decentralized. In other words, ATM switches do not have a central switch or processor that controls the activity on the network. On the other hand, Rogers discloses a method for transferring a call on a traditional telecommunications

network. Specifically, the network contemplated by Rogers uses a central processor, *i.e.* the Network Control System (NCS), to control the switches in the network and to approve call transfers. A network using ATM switches and the network contemplated by Rogers are fundamentally different, at least with respect to the present invention. Each network has different parts and implements services differently, as discussed above. Hence, Rogers is not in the same field of art. Moreover, the disclosure of Rogers does not provide any assistance to one of ordinary skill in the art attempting to develop an ATM network that provides certain telephony services more efficiently than previous ATM networks. This is because ATM networks operate quite differently than the network disclosed in Rogers. Thus, Rogers is not pertinent to the problems addressed by the present invention, namely, trying to efficiently use resources in a network with ATM switches.

Alternatively, and in addition, there is no motivation or suggestion to combine or modify the references used to reject the claims. The Examiner states the motivation/suggestion to do so is taught by Rogers at col. 4, ll. 23-24 (“This results in the voice channels 13 and 15 being available for additional calls to user-A-2.”) The fact that Rogers teaches to efficiently use telecommunications resources does not provide any motivation or suggestion to combine these references to provide the claimed method and apparatus for transferring ATM calls. See MPEP 24131.01 (“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”) (emphasis added). Nowhere does Rogers suggest that its disclosure can be or should be applied to ATM networks.

In summary, claims 1-7 and 9-15 are allowable because either Rogers is not analogous art or Rogers does not provide a motivation or suggestion to apply its teachings to ATM networks.

Claims 4, 12, and 14 are further Allowable over FIG. 1 in view of Rogers

To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03. Claims 4, 12, and 14 recite the limitation that the media access gateway sends the message to transfer to the ATM switch. At pages 5 and 6, the Office Action states that Rogers discloses sending a message from user A to the switch A through the CPE. The Office Action further states that a message sent by the media access gateway is analogous to a message sent by the user in Rogers. However, the message disclosed as sent by the user in Rogers is different than the message sent by the media access gateway as recited in claims 4, 12, and 14. In claims 4, 12, and 14, the message from the media access gateway initiates the transfer of a call between parties. In Rogers, the message sent by user A to switch A merely requests a transfer. Switch A then forwards that request to a central processor, the NCS. The “NCS 20 then returns a response message 11 to switch-A [to allow the transfer or to disallow the transfer].” Rogers at col. 3, ll. 41-53. Hence, in Rogers, the NCS sends the message to transfer the call between parties, not user A. Therefore, claims 4, 12, and 14 are allowable for the additional reason that neither Rogers nor FIG. 1 discloses the limitation that the media access gateway sends the message to transfer.

CONCLUSION

All pending claims are in condition for allowance. Allowance at an early date is solicited.

Respectfully submitted,



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